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26161	7590	11/10/2003	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			CAMPBELL, KELLY E	
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3618

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**DETAILED ACTION**

The amendment filed 8/11/03 is acknowledged.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2,6-9,11,22-24,27,57, 61-66 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Capria (US 5,249,376).

a shoe defining a normal walking direction and including:

a sole (16) defining a forward region, see Figure 1, positioned beneath toes and at least part of a ball of a foot (not shown), see Column 2, lines 32-34, received within the shoe and having a lower surface exposed across the forward region to engage a supporting surface for walking thereon;

and at least one roller (20) secured to the sole (16) and disposed rearward of the forward region, see Figure 1, the roller (20) mounted to rotate about an axle (18) defining a primary axis of rotation extending at an angle of between about zero and 45 degrees to the walking direction as viewed from above the shoe (16), see Figure 3, and able to roll sideways along a support surface, see Column 1, lines 50-56;

wherein the roller (20) is removable, see Column 2, lines 38-42;

wherein the axle (18) is mountable to the sole (16) in a plurality of selectable orientations, see Figure 3;

wherein in one of the axis orientations the axle defines an alternate axis of rotation extending substantially perpendicular to the walking direction, see figure 3;

wherein the shoe (16) can comprise two or more rollers (20) laterally spaced apart across the sole (16) or spaced apart a along the walking direction, see figure 3;

wherein the sole (16) defines a cavity (14) having an opening at the lower surface of the sole (16) defined by front and rear plates (10,12) the roller (20) partially disposed within the cavity;

wherein the roller (20) is an elongated, cylindrical, barrel-shaped wheel, see Figure 3.

With regards to claims 61-66, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. Ex parte Pfeiffer, 1962 C.D. 408 (1961).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376).

With regards to claims 10 and 12 it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the spacing between elements for increasing the user's balance when in motion, such that the spacing is to be a specific ratio, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 3-5, 16-17, 25-26, 35, 37-39, 40-51 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376) as applied to claim 1, and further in view of Adams (US 6,450,509).

Capria teaches all aspects of the claimed invention including a single axle capable of carrying multiple rollers, as discussed above for claim 1, except a retractable rolling mechanism, flexible sole and grinding plate.

Adams teaches a shoe (10) having a sole (14) and a rolling apparatus consists of two rollers (42a, 42b)

wherein the sole (14) is flexible for bending during walking, see Claim 2, for improved comfort when walking;

wherein the rolling apparatus (42a, 42b) would form a lowermost portion of the shoe (10), see Figure 7, and the two rollers (42a, 42b) have a lateral spacing and

and further including a grinding surface (44), see Figure 3a, disposed in the mid-sole area of the sole (14), see Figure 3a, and forming a laterally extending channel for receiving a rail;

wherein the sole (14) defines a cavity (40a,40b) at the lower surface of the sole (14), the rollers (42a,42b) being partially disposed within the cavity (40,40b) and extending through the cavity opening (40a,40b), see Figures 3b and figure 7;

referring to Figure 5, the roller (400), including a roller axle (62) mounted to a support cup (70) spanning the roller (400) and disposed within the sole cavity, see Column 9, lines 42-44;

wherein the roller (42) contains bearings including rolling elements, see Column 7, lines 30-54;

referring to Figures 15-17, wherein the cup enclosed the roller (900) within the cavity of the sole;

referring to Figure 18, wherein the axle (944), defines a kingpin axis about which the axle (944) rotates and can carry two rollers, see Column 12, lines 37-45 and lines 52-55 and Figure 9;

wherein the axle is disposed between a forward region and an exposed heel region of the sole (14);

wherein the kingpin (950) is defined by a pin disposed for rotation within a socket of the axle mounting structure (946) secured to the sole (14) see Column 12, lines 37-55;

wherein the kingpin axis (950) extends upward.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shoe with angularly displaced rollers as taught by Capria to include a retractable rolling mechanism for minimizing the rollers interference with the user's normal walking pattern, and a flexible soles for improved comfort to the user when walking and a grinding plate to allow the user to perform railing tricks for fun, as taught by Adams.

With regards to claims 40-41 and 49, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the fore-aft distance between mid-planes of the rollers, to be a specify amount, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376) as applied to claim 1 above, and further in view of Chu (US 6,412,791) .

Capria teaches all aspects of the claimed invention as discussed above for claim 1, except for a sole defining a cavity wherein a roller is partially disposed within the cavity and extending through the cavity.

Chu discloses a skate (1) having a sole (11) defining a cavity (13) wherein a roller (5) is partially disposed within the cavity (13) and extending through the cavity (13), the skate (1) having a removable roller assembly (5,51), see Figure 6, wherein the

roller axle (silent) is mounted to a support cup (51) spanning the roller (5) and disposed with the sole cavity (13) and wherein the support cup (51) is removable from the sole cavity (13) and wherein the support cup (51), roller (5), and axle (silent) are removable from the sole cavity (13) as a unit, and wherein the support cup (51) is selectively positionable in a first position for rolling, in which the roller (5) extends through the cavity (13) opening and a second position for walking in which the roller (5) is fully recessed within the cavity (13), see Figure 5 and 6 and column 2, lines 38-45.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shoe having rollers as taught by Capria with a removable roller assembly with supporting cup as taught by Chu in order to provide a quick convenient means for removing and reinserting the roller assembly within the shoe.

Claims 13-15, 28-33 and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Capria (US 5,249,376) as applied to claim 1, and further in view of Roderick et al (US 5,967,552).

Capria teaches all aspects of the claimed invention as discussed above for claim 1, except wherein the roller defines at least two support surface contact points.

Roderick discloses a skate (10) having a roller device (18) having two support surface contact points (80), see Figure 2 or Column 3, lines 15-23, defined on a single roller (18), wherein the rolling member is shaped to engage a flat horizontal supporting surface (20) and disposed in an arch region of the skate, see Figure 1, at one of the



contact points (80) in a first roller tilt direction (skate front or nose pointed down) and the other of the contact points (80) in a second roller tilt direction (skate rear or heel down);

wherein the roller (18) comprises a grinding surface (80) that is a circumferential surface of rolling member (18), rigidly secured to the sole of the shoe (10) ;

an alternate embodiment is disclosed wherein the rolling member (44) is shaped to engage a flat horizontal supporting surface at two contact points (44) simultaneously wherein the contact points (44) are defined on at least two independently rotatable rolling members (44), see Figure 6,

and an alternate embodiment disclosed in Figure 3, wherein there are three rolling members (104) and wherein each roller (104) is a grinding surface, a central roller (104) being a grinding surface disposed between the two outer rollers (104);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the shoes with rollers disclosed by Capria to include a roller or rollers having to points of contact as disclosed by Roderick et al in order to provide the user with increased grinding maneuverability and minimize damage to the shoe of the user from grinding.

With regards to claims 29-33, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the rolling surface span to be a specific amount, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brandner (US 4,305,598).

Brandner discloses a rolling shoe (12) having a steerable truck assembly (see Figure 1, including a pair of rollers (44) mounted to rotate about an axle secured to the sole (12) through a compliant mount (50) that allows tilting of the axle (42) with respect to the sole, see Column 3, lines 38-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a non-steerable roller, in place of an identical wheel truck mounting, omitting the compliant mount taught by Brandner, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184.

With regards to the non-steerable roller being laterally spaced from the axle of the steerable truck assembly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the non-steerable centrally disposed roller disclosed by Brandner to be laterally displaced from the front and rear steerable rollers, since it is that the rearranging of the parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

***Allowable Subject Matter***

Claim 67-105 are allowed.

Claim 34, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose a shoe defining a normal walking direction and including a sole having a forward-toe region and a rear heel region and having a lower surface of the forward region to engage a supporting surface for walking thereon and further including a steerable truck assembly secured to the sole through a compliant mount , a roller mounted to the truck assembly to rotate about an axle defining a primary axis of rotation extending at an angle between 0-45 degrees to the walking direction as viewed from above the shoe, for rolling sideways along a support surface. A combination of these and other limitations have not been reasonable found in the prior art.

***Response to Arguments***

Applicant's arguments filed 8/11/03 have been fully considered but they are not persuasive with regards to claims 1-2,6-9,11,22-24,27,57 rejected under 35 U.S.C. 102 (b) as being anticipated by Capria or claims 3-5,10,12-21,25,26,28-56 and 58-60

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rejected under 35 U.S.C. 103 (a) as obvious over Capria, or one or more of Adams (US 6,450,509), Chu (US 6,412,791), Kubierschky (US 5,443,277), and Roderick et al (US 5,967,552).

With regards to the claim recitation "...the roller positioned so as to enable rolling sideways along a support...", the term "enables" merely requires the ability to so perform. Capria clearly discloses the roller angularly secured to the lower surface of the shoe and the concept of rolling sideways along a support surface would be well known in the art. The user would simply "reposition the shoe" to engage a single row of the rollers (20), in order to slide sideways along the support surface. Sliding in a sideways direction is a "mode of personal locomotion" (*or traveling from place to place*, per Merriam-Webster's Collegiate dictionary, 10<sup>th</sup> edition, © 2000).

The applicant is reminded that In response to applicant's argument that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Applicant's arguments filed 8/11/03 have been fully considered but they are not persuasive with regards to claims 13-15,28-33 and 52-56 rejected under 35 U.S.C. 103 (a) as being obvious over Capria in view of Roderick et al (US 5,967,552).

The examiner is not intending to incorporate all of the elements of the invention of Roderick into the invention of Capria. Capria teaches all aspects of the invention except a roller having two support surface points. Roderick teaches a roller (18) having two support surface contact points. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant's arguments filed 8/11/03 have been fully considered but they are not persuasive with regards to claims 61-66 are rejected under 35 U.S.C. 102 (b) as being anticipated by Capria.

Claims 61-66 are drawn to a method of personal locomotion wherein a user may position the shoes of the invention in order to roll in the desired direction at an angle to the normal walking direction defined by the shoes. Capria discloses a shoe having rollers disposed on lower surface of the shoe at an angle to the normal walking direction such that a user would be perfectly able to roll "sideways" or at an in a

direction angled to the normal walking direction, as discussed in the above arguments regarding claim 1.

The applicant has Applicant's arguments, see Page 17, filed 8/11/03, with respect to claims 34,36 and 60 have been fully considered and are persuasive. The 103(a) rejection of claims 34,36 and 60 has been withdrawn.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brandner (US 4,305,598) teaches a skate having a compliant mounting for the wheel axle. Scollan (4,744,576) teaches a skateboard having a compliant steerable mounting for wheel axles.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

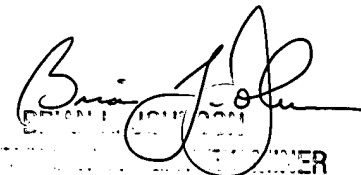
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly E Campbell whose telephone number is (703) 605-4264. The examiner can normally be reached on 9:00-5:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
KEC  
November 3, 2003

  
BRIAN JOHNSON  
SUPERVISOR  
TECHNOLOGY CENTER 6000  
11/3/03